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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,732	08/08/2001	Paola Vianello	328/US	3934

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GLOBAL PATENT DEPARTMENT
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EXAMINER

FORD, JOHN M

ART UNIT	PAPER NUMBER
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1624

8

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924732

Applicant(s)

Vianello et al

Examiner

J.M. Ford

Group Art Unit

16#

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on Dec 9, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 - 12 is/are pending in the application.
- Of the above claim(s) 9 - 12 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 - 8 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Other Exhibit A

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Applicants' response of Dec. 9, 2003, is noted.

The claims in the application are claims 1--18.

Claim 1 is extremely diverse as a result of the G variations, the G variation₃ (b--g) control the classification and search, each in a different series of multiple subclasses, the lack of restriction ~~here~~ may have to be reconsidered. The diversity of G presents a huge burden to the examiner. The heteroaryl ring of R2 is overwhelming, and must be classified to specific rings, to permit examination. In that unknown heteroaryl, the situation is made worse by the use of the open "containing", which permits further unknowns, beyond the mention O, S or N. Even 1 to 3 hetero atoms, in any combination, is huge, and requires specific conception by the reader. Not a fair burden in return for applicants obtaining a 17/20 year monopoly on compounds not demonstrated to have even been made. Accordingly, claim 1 is rejected under 35 U.S.C. 112, 2nd and first paragraphs. What is intended by the heterocyclic expression in R2, and where is that supported in the specification with adequate representative exemplification? The rejection of the previous Office Action is maintained.

This is a compound claim what compounds are being claimed?

Claims 2 and 3 are rejected as being dependent on a rejected claim.

Claim 4 is rejected as not complying with the Rules.

Claim 4 is rejected as failing to comply with 37 CFR 1.141 (a). Claim 4 is more than a reasonable number of species. Claim 4 is a list of ultimate species. Applicants paid \$18.00 for claim 4. It cost \$45.00 to search each species. Each species of claim 4 has to be searched

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separately. The USPTO is losing money on claim 4. There is no generic concept. Some of the species had to be removed from claims 1 and 2, and they were not under the earlier genus. Each species has to be separately written out, and input, into the CAS-ON-LINE search system separately. There is no claim generic to only claim 4, as required by 37 CFR 1.141 (a)

Claim 1 has some compounds removed by proviso. So, applicants cannot successfully argue unity of invention.

Claim 4 is a list of ultimate species to avoid fees. See, the memo of Richard A. Wahl, Exhibit A.

The rejection of claim 4 is continued, as it is an aggravated example of abuse of the Rules. Claim 4 is not a reasonable number of species.

In re Fressola, 22 USPQ 2nd 1828, indicates that the Examiner may reject for applicants failure to follow a Rule, see the last Office Action. Claim 4 is an aggravated example of ultimate species listed in a claim, as if to avoid fees. Claim 4 is not a Markush claim. Claim 4 is a list of ultimate species. 37 CFR 1.141 (a) provides for a reasonable number of species to be examined with the genus. Claim 4 is an aggravated example of ultimate species, each of which has to be drawn out, and classified, and searched, I cannot tell if it is patentable or not. Time is simply not provided for that type search, to permit that determination.

Claim 4 is not a Markush claim, see claim 1, and is a list of ultimate species. See the directive of Richard A. Wahl, August 10, 1968, provided as Exhibit A.

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There is a different claim requirement in 37 CFR 1.141 (a) for each ultimate species, as claim 4, here, avoids fees, the word "different" was added to stop abuse of the Rule 141.

In 1964 when I started, here, as an Examiner there was a 5 species requirement. That was changed to a reasonable number. Then the word "different" was inserted to specify that each species had to be in a different claim, so the USPQ would not lose so much money on the claim.

Claim 4 is an aggravated, multiple page, example of listing ultimate species in one claim to avoid fees. 37 CFR 1.141 (A) is said by In re Fressola to have the force of law, 22 USPQ 2nd 1828.

Claim 5 is rejected for the reasons claim 1 is/was rejected.

Claims 6 and 7 are rejected, as being dependent on a rejected claim.

What is the reason for the proviso in claims 1, 2, 5 and 6? Note 37 CFR 1.105 (amended). Is art being written around? If so, applicants claim too close to the prior art (35 U.S.C. 103). Note In re Nomiya et al., 184 USPQ 607 provides for a 35 U.S.C. 103 rejection, in view of the proviso, in that instance.

Claim 8 is an aggravated examples of abuse of the Rules as noted in the rejection of claim 4. Claim 8 is rejected for the reasons claim 4 is/was rejected.

MPEP 806.05(h) provides for restricting out the method claims, altogether, were it can be established that the compounds, as claimed, can be used for more than one purpose. Claims

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9--18 act as evidence claims to that allegation. See particularly claims 13--18. Claim 9 is not a real ~~world~~ use, and does not meet the Utility requirements. *See the last Office Action.*

John M. Ford:jmr

January 27, 2003



JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624